

Application No.: 10/672,488

Docket No.: 60680-1792

REMARKS

Applicant has reviewed the detailed Office Action mailed July 23, 2004 (Paper No. 20030926) and thanks Examiner Patel for his review of the pending claims. In the Office Action, claims 1-9 and 12-19 were rejected. Claims 10, 11 and 20 have been withdrawn. In response to the Office Action, Applicant has cancelled Claim 15 and amended Claims 12-14 and 16-17. In the course of amending the claims no new matter has been added. Thus, claims 1-9, 12-14, and 16-19 are pending in this application. Applicant requests reconsideration of the pending claims in view of the above amendments and the following remarks.

I. Election/Restrictions

An election/restriction requirement was made under 35 U.S.C. §121 between Species I, which includes Figures 1-3 and claims 1-9 and 12-19, and Species II, III, and IV which refer to the limitations of claims 10, 11 and 20, respectively. In addition, the Examiner has acknowledged that claims 1-8 and 12-18 are generic.

Applicant hereby affirms the provisional election to proceed with prosecution of claims 1-9 and 12-19 with traverse, and withdraws claims 10, 11 and 20 pursuant to 37 C.F.R. §1.142(b).

II. Specification

The Examiner has objected to informalities in the abstract of the disclosure. Applicant has amended the abstract to correct any informalities and respectfully requests reconsideration and withdrawal of the objection.

III. Claim Rejections Under 35 U.S.C. §102

Claims 12-14 and 19 were rejected under 35 U.S.C. 102(b) as being anticipated by Umezawa (U.S. Patent No. 3,671,047). Applicant respectfully traverses these rejections for the following reasons.

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To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has argued that Umezawa shows a first coating, which is made from chromium (see the Office Action at page 4, item 5). But as the Examiner expressly acknowledges, "Umezawafails to disclose that the first coating is a nodular thin dense chromium" (see the Office Action at page 4, item 7). As stated above, independent claim 12 has been amended to include a first coating of nodular thin dense chromium, which, as Applicant agrees, is not disclosed in Umezawa.

Accordingly, for at least these reasons, Applicant respectfully submits that independent claim 12, as amended, is allowable over the cited art. Dependent claims 13-14, and 19 are also allowable for at least the same reasons. Accordingly, withdrawal of these rejections is respectfully requested.

IV. Claim Rejections Under 35 U.S.C. §103

Claims 1-9 and 15-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Umezawa in view of Benson et al (U.S. Patent No. 5,829,240). As an initial point Claim 15 has been canceled and its subject matter incorporated in claim 12. Applicant respectfully traverses these rejections of the remaining claims 1-9 and 16-18 for the following reasons.

The Federal Circuit has stated, "The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a

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person of ordinary skill ... would make the combination." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

In the present case, there is no reason, suggestion or motivation to combine the non-analogous teachings of the piston ring of Umezawa, and the textile spinning rings of Benson. Clearly, the person of ordinary skill in the art of piston rings has no reason or motivation to look to the art of textile spinning. Indeed, to attempt to combine the devices of Umezawa and Benson would be to utterly destroy the essential character of both devices. The Examiner, therefore, has failed to establish a prima facie case of obviousness under 35 U.S.C. §103. Claims 1-9 and 15-18, for at least this reason, are patentable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.


CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is earnestly solicited to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1792 from which the undersigned is authorized to draw.

Dated: October 25, 2004

Respectfully submitted,

By 
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